

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

A. Status of the Claims

As a result of the present amendment, claims 1-6 and 8-17 are presented for continued prosecution.

Claims 1-6 and 8-10 have been amended for the reasons described in detail below. New matter has not been introduced.

New claims 11-17 have been added. Support for claim 11 can be found, for example, in claim 10. Support for claim 12 can be found, for example, in Figures 1-3 and in lines 4-26 on page 3 of the original application. Support for claims 13 and 14 can be found, for example, in Figures 1-3 and in lines 20-33 on page 3 of the original application. Support for claims 15-17 can be found, for example, in Figures 1-3 and in lines 5-8 on page 4 of the original application.

B. The Invention

The present invention, as defined by the amended claims, includes a dispensing device for paper sheets cut from a continuous band wound up in a roll.

In one of the novel aspects of the invention, the dispensing device includes: a) a band feeding and cutting unit configured to control feeding of a pre-established length of band and cutting of said pre-established length of band through a pull exerted by a user on a tip of paper (C) projecting from the device; b) means for retaining a starting tip (S) of said spare roll (R¹); c) means for the top hinging of said cover to said base; and d) connection means suitable to turn a push on the cover into a driving impulse for said feeding and cutting unit.

C. Objections to the Drawings

The drawings were objected to for failing to show the first and second blades recited in claim 7.

Applicant has canceled claim 7. The rejection is therefore moot.

D. Objections to the Abstract

The Examiner objected to the abstract for containing legal phraseology, for being unclear and for not commencing on a separate sheet.

Applicant respectfully reminds the Examiner that the present application is a national stage of a PCT application. According to MPEP 608.01(b)(C) and MPEP 1893.03(e), the abstract for a national stage application may be found on the front page of the Patent Cooperation Treaty publication. Nevertheless, Applicant has attached a replacement abstract which begins on a separate sheet and summarizes some aspects of the invention in proper U.S. format.

E. Objections to the Specification and Claim Rejections under 35 U.S.C. § 112, first paragraph

In section 5 of the Office Action, the Examiner objected to the specification for omitting section headings. Applicant has attached a clean copy and a marked-up copy of a substitute specification which includes section headings.

In section 6 of the Office Action, the specification had been objected to for 1) failing to teach how the pre-established length of the paper is cut; 2) failing to teach first and second blades; and 3) failing to teach how the first and second blade work with the parts of the dispensing device to cut a length of the paper. Similarly, in section 8 of the Office Action, the Examiner rejected claims 1-10 for failing to comply with the written description requirement. In particular, the Examiner makes reference to independent claim 1 and dependent claim 7 and submits that the specification fails to teach: 1) how "a pre-established length of band" or the paper is cut, 2) a cutting unit, 3) first and second blades, and 4) how the first and second blade work with the parts of the dispensing device to cut a length of paper.

Applicant respectfully disagrees with the Examiner and brings to the attention of the Examiner a passage from MPEP 2163(II)(A)(3)(a) where it is stated that "what is conventional

or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94," (emphasis added). The same MPEP section also states that "[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972).

In the present application, the type of cutting unit with first and second blades is specifically mentioned at page 1, lines 25-29 of the application as originally filed. For a detailed explanation of the operation of such a cutting unit, reference is made in the application to European patent application EP 930039 (see page 1, line 30 and page 3, line 15 of the application as originally filed). In particular, at page 3, lines 14-17 of the present application, it is clearly stated that "[f]urther details about the structure and operation of the feeding and cutting unit illustrated in fig.1 can be found in the above-mentioned patent EP 930039 that illustrates a similar unit twice the size, and provided with two pairs of blades, but having substantially the same structure." With reference to issues 1)-4) raised by the Examiner, as numbered above, the Examiner will note that:

- 1) is disclosed in EP 930039 at paragraphs [0021], [0022], [0025] and [0026]
- 2) is disclosed in EP 930039 at paragraphs [0016] to [0023]
- 3) is disclosed in EP 930039 at paragraphs [0018],[0019] and [0025] to [0027]
- 4) is disclosed in EP 930039 at paragraphs [0018], [0019] and [0025] to [0027]

Applicant also brings to the attention of the Examiner the fact that the inventor of the present application is the same inventor of EP 930039, whereby it is clear that the inventor had possession of the claimed invention at the time the application was filed. A copy of EP 930039 is attached for the Examiner's convenience.

Therefore, Applicant respectfully submits that the claimed invention complies with the written description requirement of 35 U.S.C. § 112, first paragraph, and that the specification complies with 37 C.F.R. § 1.71 in view of MPEP 2163(II)(A)(3)(a) and the above presented arguments.

F. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-10 had been rejected as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With regard to the type of feeding and cutting units referred to in the rejection, reference is made to the above presented arguments in section E.

Applicant has addressed the remaining rejections in section 10 of the Office Action concerning the transitional phrases and the lack of antecedent basis in the amended claims. It is believed that claims 1-10 comply with § 112, second paragraph.

G. Claim Objections

In section 11 of the Office Action, the Examiner objected to claims 4-10 for being improper multiple dependent claims. Applicant has removed improper multiple dependency in the amended claims.

In section 12 of the Office Action, claim 2 had been objected to for formal reasons, and the Examiner provided suggestions to overcome the formal objections. The suggestions are appreciated and have been substantially adopted herein.

H. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-3 had been rejected as being unpatentable over Granger (U.S. 6,006,642) in view of Morand (U.S. 4,846,412). Claim 1 had been rejected as being unpatentable over Morand in view of Granger.

In order to maintain an obviousness rejection under 35 U.S.C. § 103(a), the differences between the claimed invention and the prior art must be obvious to a person of ordinary skill in the art at the time the claimed invention was made. Applicant respectfully submits that the claimed invention is not obvious for at least the following reasons.

1. The combination of Granger and Morand does not teach or suggest the each element of the claimed invention

Claim 1 recites that the dispensing device includes a) a band feeding and cutting unit configured to control feeding of a pre-established length of band and cutting of said pre-established length of band through a pull exerted by a user on a tip of paper (C) projecting from the device; b) means for retaining a starting tip (S) of said spare roll (R'); c) means for the top hinging of said cover to said base; and d) connection means suitable to turn a push on the cover into a driving impulse for said feeding and cutting unit. Applicant respectfully submits that Granger in view of Morand and/or Morand in view of Granger do not teach the combination of these elements of the claimed invention.

In section 14 of the Office Action, the Examiner cited element 5 of Granger to teach the claimed band feeding and cutting unit listed in item a) above. However, to teach items b) and c) listed above, the Examiner vaguely referred to Figures 1-5 and col. 5, lines 1-64 of Granger. Figures 1-5 of Granger contain a total of about 200 reference signs, while col. 5, lines 1-64 contain about 70 reference signs. Respectfully, Applicant does not reasonably understand which elements of Granger the Examiner has cited to teach items b) and c) above. The Examiner is respectfully reminded of 37 C.F.R. § 1.104(c)(2), where Examiners are cautioned that "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified," (emphasis added). Here, the Examiner has clearly not designated the particular part relied on in Granger as nearly as practicable. It appears to Applicant that the Examiner has cited a broad portion of Granger without going into better detail in order to help Applicant understand where the features of claim 1 can be found in Granger.

Nonetheless, Applicant has reviewed all of Figures 1 through 5 and all of lines 1-64 of col. 5 of Granger, and has not found anywhere the combination of items a) through c) mentioned above. Should the Examiner still disagree with Applicant, the Examiner is requested to provide Applicant with additional guidance as to where those features are shown in Granger. In the event that the Examiner generates a second Office Action with detailed guidance on which elements of Granger are being used to reject the claims, it is respectfully requested that the

second Office Action be made non-final so that Applicant has an opportunity to directly address the elements of Granger that are believed to teach the claimed invention.

With regard to item d) listed above, the Examiner stated that this feature can be found in connection means 60 and cover 80 of Morand. Applicant respectfully disagrees. Not only is element 60 not a connection means, but it is also not connected to element 80. Applicant directs the Examiner to col. 5, lines 38-40 of Morand, where it is stated that "*the operating handle 60 is attached to the cabinet frame 12 rather than the cover 80*" (emphasis added). This passage is clearly contrary to the Examiner's reasoning.

In section 15 of the Office Action where the Examiner used Morand as the primary reference instead of Granger, Applicant also presents the above arguments. No matter whether Granger or Morand is used as the primary reference, Applicant respectfully submits that the combination of Granger and Morand does not render obvious the combination of items a) through d) of claim 1 listed above. It is therefore believed that the claimed invention is patentable over the combination of the cited references.

As mentioned above, Applicant respectfully requests that if a second Office Action is generated it should be non-final and should particularly describe which elements of the cited references are being relied upon to teach the claimed invention as required by 37 C.F.R. § 1.104(c)(2). This would provide Applicant with an opportunity to adequately distinguish the claimed invention from the cited references.

I. Fees

This Response is being filed within the shortened statutory period for reply. No fee is believed to be due. If, on the other hand, it is determined that fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

J. Conclusion


In view of the actions taken and arguments presented, it is respectfully submitted that each and every one of the matters raised by the Examiner has been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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<p>CERTIFICATE OF ELECTRONIC TRANSMISSION I hereby certify that this document is being electronically transmitted to the Commissioner for Patents via EFS-Web on July 9, 2008.</p> <p>LUCAS & MERCANTI, LLP</p> <p>By: _____ Timothy D. Meade</p>
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Attached: Replacement abstract
Clean copy of substitute specification
Marked-up copy of substitute specification
Copy of EP 0 930 039